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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/577,005 05/25/00 ASAKURA

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OBLON SPIVAK MCCLELLAND
MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

HM12/0910

EXAMINER

TUNG, P

ART UNIT

PAPER NUMBER

1652

8

DATE MAILED:

09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/577,005

Applicant(s)

Asakura et al.

Examiner

Peter Tung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication; even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 2, drawn to a method of producing coryneform bacteria having an improved amino acid productivity, classified in class 435, subclass 471.
 - II. Claims 1 and 2, drawn to a method of producing coryneform bacteria having an improved nucleic acid productivity, classified in class 435, subclass 471.
 - III. Claims 12 and 14, drawn to a glutamic acid synthesizing gene having a specific promoter and a coryneform bacterium comprising said gene, classified in class 435, subclass 183.
 - IV. Claims 13 and 15, drawn to an arginine synthetase gene having a specific promoter and a coryneform bacterium comprising said gene, classified in class 435, subclass 183.
 - V. Claim 16, drawn to a method of producing a nucleic acid by culturing a coryneform bacterium, classified in class 435, subclass 84.
 - VI. Claims 16 and 17, drawn to a method of producing an amino acid by culturing a coryneform bacterium, classified in class 435, subclass 106.
2. The inventions are distinct, each from the other because of the following reasons:

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3. Each of Groups I, II, V and VI is directed to a separate and distinct invention. Group I is directed to a method of producing coryneform bacteria having an improved amino acid productivity, Group II is directed to a method of producing coryneform bacteria having an improved nucleic acid productivity, Group V is directed to a method of producing a nucleic acid by culturing a coryneform bacterium and Group VI is directed to a method of producing an amino acid by culturing a coryneform bacterium. These methods are distinct both physically and functionally, require different process steps, reagents and parameters and produce different products.

Each of Groups III and IV is directed to a separate and distinct invention. Group III is directed to a glutamic acid synthesizing gene having a specific promoter and a coryneform bacterium comprising said gene and Group IV is directed toward a glutamic acid synthesizing gene having a specific promoter and a coryneform bacterium comprising said gene.

4. The products of Groups III and IV would be expected to have distinct morphological, functional, chemical and physical properties as indicated by their divergent classification, process of making and process of using. These products are capable of separate manufacture, use, or sale as claimed, and are patentably distinct.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: In claim 2, the species of amino acids: glutamic acid, lysine, arginine, serine, phenylalanine, proline and glutamine; the species of nucleic acid: inosine, guanosine, and adenosine nucleotides. In claim 3, the promoters for the genes of: glutamate dehydrogenase, citrate synthase, isocitrate synthase, pyruvate dehydrogenase and aconitase.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Upon the election of Group I, an election of the species of amino acid is required. With the election of species of glutamic acid in claim 2, an election of the specific gene promoter in claim 3 is required. Those claims of claims 4-11 corresponding to these species elections will then be included for examination. For example an election of the species of arginine in claim 2 will then include examination of claims 1, 2 and 9-11. Election of glutamic acid and citrate synthase gene promoter will include examination of claims 1-3 and 6.

Upon the election of Group II, an election of the species of the nucleic acids is required.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon.

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Claim 16 is generic to a plurality of disclosed patentably distinct species comprising amino acids (Group VI). Claim 16 is generic to a plurality of disclosed patentably distinct species comprising nucleic acids (Group V). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

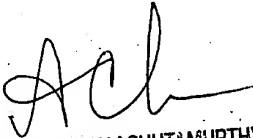
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Tung, Ph.D. whose telephone number is (703) 308-9436. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, Ph.D., can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600